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DOUGLAS E. MORRIS
2702 TRIANA BOULEVARD, SUITE C
HUNTSVILLE, VA 22202

In re Application of KENNEDY et al. : DECISION ON
Application No.: 09/787,103 :
PCT No.: PCT/ZA99/00085 : PETITION UNDER
Int. Filing: 14 September 1999 :
Priority Date: 14 September 1998 : 37 CFR 1.47(a)
Attorney Docket No.: KEN3/WAB :
For: VIDEO GAMING DEVICE AND :
COMMUNICATIONS SYSTEM :
:

Dear Mr. Morris:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Leonard E. Smith
Legal Examiner
PCT Legal Office

CMK/LES:cmk

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

WILLIAM A BLAKE
JONES TULLAR & COOPER
PO BOX 2266 EADS STATION
ARLINGTON, VA 22202



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This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 25 July 2001. Applicant also requests a one month extension of time, which is granted.

BACKGROUND

On 25 July 2001, applicant, in response to 25 April 2001 Notification of Missing Requirements, filed the instant petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requests the acceptance of the application without the signatures of inventors, Michael A. Morris and Douglas E. Morris on the grounds that the non-signing inventors refused to execute the declaration. The petition included the requisite petition fee, a verified statement of William A. Blake, attorney for applicant, regarding Messrs. Morris refusal to sign and a declaration signed by the 37 CFR 1.47(a) applicant, Julian J. Kennedy.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

As for item (1), the fee of \$130 has been paid. With respect to item (3), a statement of the last known address of the non-signing inventor(s) has been provided. As for item (4), an oath or declaration by joint inventor Julian J. Kennedy on his own behalf and on behalf of the non-signing joint inventor(s) has also been submitted.

With respect to item (2), Petitioner has submitted a statement in support of the petition under 37 CFR § 1.47(a)(2) executed by Mr. Blake, having first hand knowledge. Mr. Blake provided a copy of a letter dated May 17, 2001 and sent to the last known address of both of the non-signing inventors. The letter indicated that a copy of the PCT publication and a declaration and power of attorney were enclosed. According to Mr. Blake's statement, the papers were returned in the unopened envelope marked, "NOT DELIVERABLE AS ADDRESSED; UNABLE TO FORWARD". A copy of the envelope accompanied the petition.

Thereafter, on 07 June 2001, Mr. Blake sent an E-mail to Michael Morris, stating that an executed declaration and power of attorney were required to continue prosecution of the application. Mr. Blake stated: "We attempted to send this document to your last known address, 2702 Triana Boulevard, Suite C, Huntsville, AL 35805, but it was returned marked "unable to forward". I would therefore appreciate it if you could provide me with an address where the document can be sent." By return E-mail, Michael Morris replied: "we will not execute any further assignments until our equipment...is paid for or return [sic] in worked order". Mr. Morris did not provide a mailing address.

By return E-mail, Mr. Blake responded: that "the document in question is not an assignment, but an inventor declaration and power of attorney that confirms you are an inventor and gives our firm power to prosecute the application. However, I assume from what you said, that you will not execute any further documents for this case."

Petitioner has now demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/787,103 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signatures, sent to their last known mailing address and (2) Mr. Morris' refusal to sign these documents as evidenced in his E-mail dated 07 June 2001 by not providing a "good" mailing address.

In sum, the evidence submitted indicates that applicants made diligent efforts to reach the non-signing inventors and supports a finding that the nonsigning inventors refuse to sign the application for the reasons set forth above. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 07 June 2001 and to mail a filing receipt. The application has an international filing date of 14 September 1999 under 35 U.S.C. 363, and a date of 07 June 2001 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.



Leonard E. Smith
Legal Examiner
PCT Legal Office

CMK/LES:cmk



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467